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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,867	11/21/2003	Andrew James Thomas	22493-141U (162731DU501U)	2920
31292 7590 03/02/2010 CHRISTOPHER & WEISBERG, P.A. 200 EAST LAS OLAS BOULEVARD SUITE 2040 FORT LAUDERDALE, FL 33301				
EXAMINER WINTER, JOHN M				
ART UNIT 3685		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,867

Applicant(s)

THOMAS ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 20, 21, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 20-21 and 29-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on November 9, 2009 is hereby acknowledged, Claims 1-14, 20-21 and 28-31 are pending.

Response to Arguments

2. Applicant's arguments with respect to the pending claim have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14, 20-21 and 28-29 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 1-14, 20-21, 29 and 31 are “software per se” the claimed “structure” of the invention is composed entirely of software (e.g. controller, interface) and as such is non-statutory.
5. Examiner notes that Applicant states “the program controller being in the form of software” at page 11, line 23 of the specification filed on November 11, 2003.
6. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760

(claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. (MPEP 2106.01 --FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES")

7. Claim 28 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

8. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

9. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

10. In this particular case, claim 28 fails prong (1) because the “tie” (e.g. a hardware module) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-14,20-21 and 29-30 are rejected under 35 U.S.C. 102(b) as being unpatentable over Katz et al (US Patent 5,926,624).

12. As per claim 1,

Katz ('624) discloses a program controller arranged for use with a modular system,(Column 11, lines 1-31). Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claims 2-14 20-21 and 29-30 contains similar limitations or are dependant upon claim 1 and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 1-14, 20-21 and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US Patent 5,926,624) in view of Narasimhalu (US Patent 5,499,298).

14. As per claims 1, 20 and 28-30

Katz ('624) discloses a program controller arranged for use with a modular system, and arranged to manage a program for use with a replaceable hardware module of the modular system, the module being a customer-replaceable part, (Column 11, lines 1-31)

Katz ('624) does not specifically disclose "the controller being arranged to manage the program automatically according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller, and according to a stored history of use of the hardware module". Narasimhalu ('298) discloses "the controller (column 8, lines 44-46) being arranged to manage the program automatically according to an agreement between a supplier and a customer, (column 8, line 64-column 9, line 6; column 8, lines 37-51) the agreement having terms stored within the program controller, (column 10 lines 25-31) and according to a stored history of use of the hardware module (column 9, lines 25-26)". It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Katz ('624) method in view of Narasimhalu

(‘298) in order to control usage of content data Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). The claimed features of “arranged to manage” etc.. fails to limit the claimed invention.

15. As per claim 2,
Katz (‘624) discloses the program of claim 1,
the history being stored on the hardware module. (Column 8, lines 19-27)

16. As per claim 3,
Katz (‘624) discloses the program controller of claim 1
arranged to be part of a shelf controller for managing modules in the form of cards for carrying out functions of a network element for a telecommunications network.(Figure 4)
Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

17. As per claim 4,
Katz (‘624) discloses the program controller of claim 1

the program controller being arranged to determine an identity of the system and check it is authorized for use with that system. (Column 14, line 28; discussion of “digital signature protocol”)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

18. As per claim 5,
Katz ('624) discloses the program controller of claim 1
the history comprising a program identifier of a program previously loaded on the module.
(Column 8, lines 19-27)

19. As per claim 6,
Katz ('624) discloses the program controller of claim 1
the history comprising a licence identifier of a program previously loaded on the module.
(Column 8, lines 19-27)

20. As per claim 7,
Katz ('624) discloses the program controller of claim 1
arranged to be located remotely from the system, and coupled to the system by a
communications link.(Figure 4)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

21. As per claim 8,

Katz discloses the program controller of claim 1, arranged to maintain an inventory record of identities and relationships of modules, programs, and licence information for a given customer. (Column 14, line 28; discussion of “digital signature protocol”)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

22. As per claim 9,

Katz (‘624) discloses the program controller of claim 1 arranged to determine any changes in modules, at initialization, and to check the configuration of any newly coupled modules. (Column 14, line 28; discussion of “digital signature protocol”) Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

As per claim 10,

23. Katz ('624) discloses the program controller of claim 1

Wherein the controller copies all or part of the program to the module at initialization.

(Column 14, line 28; discussion of "digital signature protocol")

24. As per claim 11,

Katz ('624) discloses the program controller of claim 1

Wherein the controller authorizes all or part of the program for the module at initialization.

(Column 15, line 63 – column 17, line 24)

25. As per claim 12,

Katz ('624) discloses the program controller of claim 1

the history comprising an indication of which systems the module has been coupled to.

(Column 14, line 28; discussion of "digital signature protocol")

26. As per claim 13,

Katz ('624) discloses the program controller of claim 1

the program having license information indicating a capability licensed, the program controller being arranged to configure the program according to the capability licensed.

(Column 14, line 28; discussion of "digital signature protocol")

Examiner notes that while features of an apparatus may be recited either structurally or

functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

27. As per claim 14,
Katz ('624) discloses the program controller of claim 1
the program having license information indicating license expiry information. (Column 14, line 28; discussion of "digital signature protocol")

28. As per claim 21,
Katz ('624) discloses the program controller of claim 20
having an interface for coupling to a remote server to pass
information for a supplier to maintain an inventory of programs and modules.(Figure 4)
Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
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